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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,676	09/04/2001	Heinz-Ulrich Diestelhorst	MFA-13302/04	7054

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GIFFORD, KRASS, GROH, SPRINKLE
ANDERSON & CITKOWSKI, PC
280 N OLD WOODARD AVE
SUITE 400
BIRMINGHAM, MI 48009

EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 12/24/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,676

Applicant(s)

DIESTELHORST ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 11, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11, 13 and 14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 . 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species 1 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. This Office Action acknowledges the applicant's Amendment A, presented as Paper No. 5. Claims 1-16 are pending in the application. Claims 11, 13, and 14 are withdrawn from further consideration as being directed to a non-elected species. The applicant has canceled claim 17.

Specification

3. The abstract of the disclosure is objected to because of the use of legal phraseology. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

4. The applicant uses the phrase "in particular" through the claim set to denote a subset. The use of this terminology when defining structure sometimes renders the claim indefinite (those that are rendered indefinite are rejected below). The applicant should carefully review the claims to ensure they meet the requirements of 35 U.S.C. 112.

5. The applicant often uses reference characters to denote structure. Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10, 12, 15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "releasably connected", and the claim also recites, "in particular latched" which is the narrower statement of the range/limitation.

Further regarding claim 1, it is indefinite as to what structure is "being formed for the connection to a carrier (42)".

Claims 2-15 are dependent on claim 1 and are rejected for the above reasons.

Claim 3 recites the broad recitation "at least in part", and the claim also recites, "preferably substantially in full" which is the narrower statement of the range/limitation.

Claim 4 recites the limitation "at least one of the narrow sides (28)" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "latching means (36)" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "latching means (36)" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim. It is further indefinite as to the number of latching means claimed and the location and construction of each.

Claim 7 is dependent on claim 6 and is rejected for the above reason.

Regarding claim 8, it is indefinite as to whether the slot is at least substantially or completely closed.

Claim 10 recites the broad recitation "connected", and the claim also recites, "in particular releasably connected" which is the narrower statement of the range/limitation. It is further indefinite as to whether form the carrier is limited to the listed forms.

Claim 15 recites the broad recitation "reusable material", and the claim also recites, "in particular of plastic, preferably polypropylene, or of cardboard or card" which is the narrower statement of the range/limitation.

Regarding claim 16, it is indefinite as to what structure is "being formed for the connection to a carrier (42)".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Schweinsberg (EP 0 289 698 A2).

The examiner interprets the coupling member, not the housing as capable of attachment to a carrier.

Schweinsberg discloses a coupling member (60, Figures 6-8). The coupling member of Schweinsberg is capable of functioning as claimed by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. Claims 1, 2, 8-10, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gloger (US 5,676,246) in view of Schweinsberg.

Since the examiner is required to interpret the claims in the broadest reasonable sense, in all cases of broader limitations followed by narrower limitations, the examiner interprets the broader limitation to be the structure claimed by the applicant.

Regarding claim 1, Gloger '246 discloses an apparatus for storing disk-shaped storage media with a flat housing (10) and a slot opening (22).

Gloger '246 lacks or does not expressly disclose a coupling member.

Schweinsberg discloses a coupling member (60, Figures 6-8) for coupling a media storage disk to a carrier. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the housing of Gloger '246 with a coupling member as taught by Schweinsberg in order to retain several disks within a single package. The assembly of Gloger-Schweinsberg is capable of functioning as claimed by the applicant.

As to claim 2, the assembly of Gloger-Schweinsberg is releasable connected to a carrier through pins (Schweinsberg 80, 82).

As to claim 8, the slot of the assembly of Gloger-Schweinsberg is closed when the coupling member is inserted.

As to claim 9, the assembly of Gloger-Schweinsberg discloses an abutment edge (Schweinsberg, lower bound of slots 72 and 74).

As to claim 10, the assembly of Gloger-Schweinsberg discloses coupling elements (Schweinsberg 80, 82), which can be connected to a carrier (see Schweinsberg, Figure 1).

As to claim 12, the assembly of Gloger-Schweinsberg discloses coupling elements (Schweinsberg 80, 82), which can be connected to a carrier (see Schweinsberg, Figure 1). The coupling member remains in one piece during this process.

As to claim 15, the assembly of Gloger-Schweinsberg discloses the claimed invention except for the coupling member made of a reusable material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the coupling member of Gloger-Schweinsberg in a reusable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

9. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gloger-Schweinsberg as applied to claim 1 above, and further in view of Saito (US 4,476,978).

Regarding claim 3, the assembly of Gloger-Schweinsberg discloses the claimed invention except for the semi-circular cutout. Saito discloses a coupling member (17) with a semi-circular cutout. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the assembly of Gloger-Schweinsberg

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with a semi-circular cutout as taught by Saito in order to reduce the overall length of the assembly.

As to claims 4-7, the assembly of Gloger-Schweinsberg-Saito discloses the claimed latching arrangement (see Saito, Figure 3a).


Conclusion

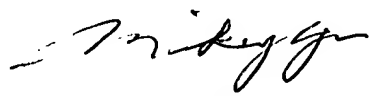
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lin discloses a coupling member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Gregory Pickett
Examiner
December 17, 2003


Mickey Yu
Supervisory Patent Examiner
Group 3700